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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/765,763	01/19/2001	Roger P. Hoffman	P2/89	9720
7590		02/07/2013	EXAMINER	
Philip M. Weiss WEISS & WEISS Suite 105 410 Jericho Turnpike Jericho, NY 11753			BORISOV, IGOR N	
			ART UNIT	PAPER NUMBER
			3628	
			MAIL DATE	
			02/07/2013	
			DELIVERY MODE	
			PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/765,763	Applicant(s) HOFFMAN, ROGER P.
	Examiner IGOR BORISOV	Art Unit 3628

– The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 26 November 2012.

2a) This action is **FINAL**. 2b) This action is non-final.

3) An election was made by the applicant in response to a restriction requirement set forth during the interview on _____; the restriction requirement and election have been incorporated into this action.

4) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

5) Claim(s) 1-4-6 and 8-17 is/are pending in the application.

5a) Of the above claim(s) 4,5,8 and 10-17 is/are withdrawn from consideration.

6) Claim(s) _____ is/are allowed.

7) Claim(s) 1,6 and 9 is/are rejected.

8) Claim(s) _____ is/are objected to.

9) Claim(s) _____ are subject to restriction and/or election requirement.

* If any claims have been determined **allowable**, you may be eligible to benefit from the **Patent Prosecution Highway** program at a participating intellectual property office for the corresponding application. For more information, please see http://www.uspto.gov/patents/init_events/pph/index.jsp or send an inquiry to PPHfeedback@uspto.gov.

Application Papers

10) The specification is objected to by the Examiner.

11) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)

3) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____

2) Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____

4) Other: _____

DETAILED ACTION

Response to Amendment

Amendment received on 11/26/2012 is acknowledged and entered. Claims 4, 5, 8, 10-17 have been withdrawn. Claims 2-3 and 7 have been canceled. Claims 1 and 6 have been amended. Claims 1, 4-6 and 8-17 are currently pending in the application.

Claim Rejections - 35 USC § 112

The following is a quotation of 35 U.S.C. 112(a):

(a) IN GENERAL.—The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor or joint inventor of carrying out the invention.

The following is a quotation of 35 U.S.C. 112 (pre-AIA), first paragraph: The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 6 and 9 are rejected under 35 U.S.C. 112(a) or 35 U.S.C. 112 (pre-AIA), first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor or a joint inventor, or for pre-AIA the inventor(s), at the time the application was filed, had possession of the claimed invention. As currently amended, independent claims 1, 6 and 9 include the following limitation: "a computer database *having* an industry related portal". Specification does not provide support for this limitation.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 6 and 9 are rejected under 35 U.S.C. 112, second paragraph, as

being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Independent claim 1 recites:

1. (Currently Amended) An integrated portal system consisting of;

a computer database having an industry related portal, and

a second portal of a different industry;

said system integrating said portals so that a user simultaneously displays information related to said portal and said second portal on a screen, and simultaneously search within both portals.

In accordance with MPEP 2111.03, the transitional phrase "consisting of" excludes any element, step, or ingredient not specified in the claim. *In re Gray*, 53 F.2d 520, 11 USPQ 255 (CCPA 1931); *Ex parte Davis*, 80 USPQ 448, 450 (Bd. App. 1948) ("consisting of" defined as "closing the claim to the inclusion of materials other than those recited except for impurities ordinarily associated therewith."). But see *Norian Corp. v. Stryker Corp.*, 363 F.3d 1321, 1331-32, 70 USPQ2d 1508, 1516 (Fed. Cir. 2004) (holding that a bone repair kit "consisting of" claimed chemicals was infringed by a bone repair kit including a spatula in addition to the claimed chemicals because the presence of the spatula was unrelated to the claimed invention).

Claim 1 requires simultaneous display of information on a screen, and simultaneous search functionality within both portals. However, claim 1 does not recite necessary elements to enable said functionality, there is no machine configured to execute said search and said displaying, and there is no display recited in the claim. Searching "engine" can be stored in the database as a software/code, but the database does not execute said "engine" on its own, a processor does. So as a transitional phrase "consisting of" excludes other elements from the claim including the processor, it is unclear how said functionality is enabled. Same rationale is applied to remaining independent claims 6 and 9.

Further, Claims 1, 6 and 9 are directed to a system and recite the following structural elements: "an industry related portal"; and "a second portal of a different industry", which is confusing.

The specification [0007] defines the portal as following:

It is an object of the present invention for each of said portals to contain a mini portal and a micro portal. It is an object of the present invention for the system to have *a search engine, which can search a single portal having micro and mini portals or to search between portals.*

Apparently, the specification defines a "portal" as a collection of data files, or data per se. Further, Microsoft © Computer Dictionary, 4th Ed. 1999, P. 124 defines the data file as: "A file consisting in the form of text, numbers or graphics, as distinct from a program file of commands and instructions". Accordingly, data file is not a structural element but is nothing more than information organized in certain way.

Therefore, it is not clear to what extent the term "portal" represents a structural element.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chipman et al. (US 6,292,894) in view of Krishan et al. (US 6,442,529).

Chipman et al. (Chipman) teach a system for retrieving, organizing and utilizing networked data, consisting essentially of (For the purposes of searching for and applying prior art under 35 U.S.C. 102 and 103, absent a clear indication in the specification or claims of what the basic and novel characteristics actually are, "consisting essentially of" will be construed as equivalent to "comprising." See, e.g., PPG, 156 F.3d at 1355, 48USPQ2d at 1355):

As per claim 1,

an industry related portal/database (column 4, lines 10-17);
a second portal/database of a different industry (column 4, lines 10-17), Chipman explicitly teaches that applications of said invention may include various industries,

including aerospace industry, automotive industry, electronics, pharmaceutical and other industries (C. 14, L. 7-12);

 said system integrating said portals so that a user can search said databases and view information relating to both portals in a single system (column 2, lines 46-54; column 3, lines 51-65; C. 9, L. 39).

 Chipman does not explicitly teach that information related to a first and second portal is displayed simultaneously.

 Krishan et al. (Krishan) teaches a system for delivering targeted information and advertising over the Internet, wherein users are provided with an access to the Internet via Internet services providers (ISP) or via "mini-portals" provided by different entities in such a way that information provided by said "mini-portals" and different entities displayed simultaneously (Fig. 9; C. 6, L.2-48; C. 20, L. 28-41).

 It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Chipman to include that information related to a first and second portal displayed simultaneously, as disclosed in Krishan, because it would advantageously simplify the process of selection of topic of interest for the user by not having to memorize the content of each separate Web page. Furthermore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Chipman to include that information related to a first and second portal is displayed simultaneously, as disclosed in Krishan, since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art

would have recognized that the results of the combination were predictable. The rationale to support a conclusion that the claim would have been obvious is that all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination yielded nothing more than predictable results to one of ordinary skill in the art. KSR, 550 U.S. at, 82 USPQ2d at 1395; *Sakraida v. AG Pro, Inc.*, 425 U.S. 273, 282, 189 USPQ 449, 453 (1976); *Anderson's-Black Rock, Inc. v. Pavement Salvage Co.*, 396 U.S. 57, 62-63, 163 USPQ 673, 675 (1969); *Great Atlantic & P. Tea Co. v. Supermarket Equipment Corp.*, 340 U.S. 147, 152, 87 USPQ 303, 306 (1950).

Further, as per transitional phrase “consisting of”, it is noted, that it appears that the combination of Chipman and Krishan teaches an integrated portal system, wherein the system includes the recited above structural elements, and it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the combination to exclude nonessential structural elements disclosed in the combination to address the scope of claim 1, and one of ordinary skill in the art would have recognized that excluding the nonessential steps would have yielded predictable results of arriving to the same system as a whole. The level of ordinary skill in the art demonstrated by the references applied shows the ability to incorporate such exclusion.

As per claim 9, Chipman teaches:

an industry related portal/database (column 4, lines 10-17);

a second portal/database of a different industry (column 4, lines 10-17), Chipman explicitly teaches that applications of said invention may include various industries, including aerospace industry, automotive industry, electronics, pharmaceutical and other industries (C. 14, L. 7-12);

said system integrating said portals so that a user can search said databases and view information relating to both portals in a single system (column 2, lines 46-54; column 3, lines 51-65; C. 9, L. 39); and

a program for online communication between individuals (data exchange) within an industry related portal and a second portal (Figs. 5 and 6; C. 6, line 63 – C. 7, line 14).

Chipman does not explicitly teach that information related to a first and second portal is displayed simultaneously.

Krishan teaches a system for delivering targeted information and advertising over the Internet, wherein users are provided with an access to the Internet via Internet services providers (ISP) or via “mini-portals” provided by different entities in such a way that information provided by said “mini-portals” and different entities is displayed simultaneously (Fig. 9; C. 6, L.2-48; C. 20, L. 28-41), and wherein online communication between individuals (email and voice mail) within an industry related portal and a second portal is provided (C. 11, L. 50-55; C. 21, L. 12-36).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Chipman to include that information related to a first and second portal is displayed simultaneously, as disclosed in Krishan, because it would

advantageously simplify the process of selection of topic of interest for the user by not having to memorize the content of each separate Web page. Furthermore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Chipman to include that information related to a first and second portal is displayed simultaneously, as disclosed in Krishan, since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable. The rationale to support a conclusion that the claim would have been obvious is that all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination yielded nothing more than predictable results to one of ordinary skill in the art. KSR, 550 U.S. at, 82 USPQ2d at 1395; Sakraida v. AG Pro, Inc., 425 U.S. 273, 282, 189 USPQ 449, 453 (1976); Anderson's-Black Rock, Inc. v. Pavement Salvage Co., 396 U.S. 57, 62-63, 163 USPQ 673, 675 (1969); Great Atlantic & P. Tea Co. v. Supermarket Equipment Corp., 340 U.S. 147, 152, 87 USPQ 303, 306 (1950).

Further, as per transitional phrase "consisting of", it is noted, that it appears that the combination of Chipman and Krishan teaches an integrated portal system, wherein the system includes the recited above structural elements, and it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the combination to exclude nonessential structural elements disclosed in the

combination to address the scope of claim 9, and one of ordinary skill in the art would have recognized that excluding the nonessential steps would have yielded predictable results of arriving to the same system as a whole. The level of ordinary skill in the art demonstrated by the references applied shows the ability to incorporate such exclusion.

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chipman et al. in view of Krishan et al. and further in view of Rangan (US 6,412,073).

As per claim 6, Chipman teaches:

an industry related portal/database (column 4, lines 10-17);
a second portal/database of a different industry (column 4, lines 10-17), Chipman explicitly teaches that applications of said invention may include various industries, including aerospace industry, automotive industry, electronics, pharmaceutical and other industries (C. 14, L. 7-12);

said system integrating said portals so that a user can search said databases and view information relating to both portals in a single system (column 2, lines 46-54; column 3, lines 51-65; C. 9, L. 39).

Chipman does not explicitly teach that information related to a first and second portal is displayed simultaneously.

Krishan teaches a system for delivering targeted information and advertising over the Internet, wherein users are provided with an access to the Internet via Internet

services providers (ISP) or via "mini-portals" provided by different entities in such a way that information provided by said "mini-portals" and different entities is displayed simultaneously (Fig. 9; C. 6, L.2-48; C. 20, L. 28-41).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Chipman to include that information related to a first and second portal is displayed simultaneously, as disclosed in Krishan, because it would advantageously simplify the process of selection of topic of interest for the user by not having to memorize the content of each separate Web page. Furthermore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Chipman to include that information related to a first and second portal is displayed simultaneously, as disclosed in Krishan, since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable. The rationale to support a conclusion that the claim would have been obvious is that all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination yielded nothing more than predictable results to one of ordinary skill in the art. KSR, 550 U.S. at, 82 USPQ2d at 1395; *Sakraida v. AG Pro, Inc.*, 425 U.S. 273, 282, 189 USPQ 449, 453 (1976); *Anderson's-Black Rock, Inc. v. Pavement Salvage Co.*, 396 U.S. 57, 62-63, 163 USPQ 673, 675 (1969); *Great*

Atlantic & P. Tea Co. v. Supermarket Equipment Corp., 340 U.S. 147, 152, 87 USPQ 303, 306 (1950).

The combination of Chipman and Krishan does not specifically teach a transaction-tracking component.

Rangan teaches a method and system for user-interactive portals accessible via the Internet, wherein a facility is provided for automatically tracking transactions made at various destinations (column 8, lines 20-21).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the combination of Chipman and Krishan to include transaction tracking component, as disclosed in Rangan, because it would advantageously allow to automate processing of the transactions for the users, as specifically stated in Rangan (C. 8, L. 19-23). Alternatively, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the combination of Chipman and Krishan to include transaction tracking component, as disclosed in Rangan, since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable. The rationale to support a conclusion that the claim would have been obvious is that all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination yielded nothing more than predictable results to one of ordinary skill in the

art. KSR, 550 U.S. at, 82 USPQ2d at 1395; *Sakraida v. AG Pro, Inc.*, 425 U.S. 273, 282, 189 USPQ 449, 453 (1976); *Anderson's-Black Rock, Inc. v. Pavement Salvage Co.*, 396 U.S. 57, 62-63, 163 USPQ 673, 675 (1969); *Great Atlantic & P. Tea Co. v. Supermarket Equipment Corp.*, 340 U.S. 147, 152, 87 USPQ 303, 306 (1950).

Further, as per transitional phrase "consisting of", it is noted, that it appears that the combination of Chipman, Krishan and Rangan teaches an integrated portal system, wherein the system includes the recited above structural elements, and it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the combination to exclude nonessential structural elements disclosed in the combination to address the scope of claim 6, and one of ordinary skill in the art would have recognized that excluding the nonessential steps would have yielded predictable results of arriving to the same system as a whole. The level of ordinary skill in the art demonstrated by the references applied shows the ability to incorporate such exclusion.

Response to Arguments

Applicant's arguments filed 11/26/2012 have been fully considered but they are not persuasive.

In response to applicant's argument that amended claims recite a computer database which executes searching functionality, it is noted that the database may include a searching "engine" stored therein as a software, or code per se, but the database does not execute said "engine" on its own, a processor does. So as a

transitional phrase "consisting of" excludes other elements from the claim including the processor, it is unclear how said functionality is enabled.

Remaining Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Igor Borissov whose telephone number is 571-272-

6801. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hayes can be reached on 571-272-6708. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Igor N. Borissov/
Primary Examiner, Art Unit 3628
2/6/2013